

USSN: 09/854,824

Docket No.: 56466US002

REMARKS

Claims 1-39 are pending in the application.

Claim Rejections Under 35 U.S.C. § 112

Claim 19 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that "no active agent is listed."

Applicants respectfully point out that "active agent is defined on page 4, lines 8-13, as "any agent providing any treatment to a user, whether or not the agent possesses biological activity." Thus, active agents include ... "cosmetic agents such as ... decorative treatments." Glitter, ornamental design mask, applique and tattoos are decorative treatments that are active agents as defined by applicants in the Specification. The applicants have defined the term "active agents" sufficient to place one skilled in the art on notice of the scope of the term. Accordingly, applicants' respectfully request that the rejection be withdrawn.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by USPN 5,276,079 to Duan. The Examiner cites Duan to disclose a pharmaceutical delivery device "employing hydrophilic, pressure sensitive adhesive composition which is useful for delivering active agents to our through the skin . . ." that includes a pressure sensitive adhesive layer, a backing layer (made of polyethylene or ethylene-vinyl acetate copolymer), and a release liner that is considered by the Examiner as a support layer.

Applicants respectfully traverse the rejection. First, the backing layer in Duan is comprised of polyethylene and ethylene-vinyl acetate copolymers. These materials are neither water-soluble nor water-dispersible. Further, Duan fails to disclose a plasticizer for use in the backing layer.

Second, Duan fails to disclose a water-soluble or water-dispersible adhesive. Rather, Duan teaches in Comparative Example 8 that a composition prepared with

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glycerin, water and uncrosslinked PVP (which can be water soluble) "fails to achieve adhesive properties required for the present invention".

Further, Duan fails to disclose a construction of the device in which the support layer is attached to the carrier layer on the surface opposite the adhesive layer, i.e. a construction of 1) support layer, 2) carrier layer, 3) adhesive layer. Rather, Duan teaches the construction of the dressing in order of the layers as 1) backing layer, 2) adhesive layer, 3) release liner. In Duan's construction, the release liner (the support layer) covers the application surface of the adhesive layer that is placed against the skin. Thus, the release liner in Duan is not attached to a surface of the backing layer.

Because Duan fails to disclose every element of independent claims 1 and 15, applicants request that the rejections under 35 U.S.C. § 102(b) should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-39 are rejected under 35 U.S.C. § 103(a) as obvious over Duan. The Examiner acknowledges that Duan fails to teach a substantially water soluble carrier but relies on Duan's disclosure of a "hydrophilic, pressure sensitive adhesive composition" (emphasis in original Office Action) to conclude that it would have been obvious to use the Duan reference with the expected result of "a device comprising a pressure-sensitive adhesive composition which comprises a polymer and a plasticizer."

The present rejection of the pending claims does not set forth a case of *prima facie* obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art to modify the reference; there must be a reasonable expectation of success; and the prior art reference must teach or suggest all the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

As discussed above relating to the 35 U.S.C. § 102(b) rejection, Duan fails to disclose either a water-soluble carrier layer or water-soluble pressure sensitive adhesive layer. Applicants dispute the Examiner's conclusion that Duan would motivate someone skilled in the art to use the pressure sensitive adhesive composition disclosed in Duan for the pressure sensitive adhesive layer of Applicants' invention because

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Duan teaches that water-soluble components in the composition are undesirable (see Comparative Example 8).

Further, even assuming that Duan would motivate someone skilled in the art to use the pressure sensitive adhesive composition disclosed in Duan for the pressure sensitive adhesive layer of Applicants' invention, that modification still fails to meet all limitations of Applicants' claims. There is no teaching to use a water-soluble backing layer, which could be considered equivalent to applicant's carrier layer. Additionally, there is no teaching to use a support layer releasably adhered to the carrier layer on the carrier surface opposite the carrier surface attached to the adhesive layer.

For all the above reasons, Duan fails to disclose the combination of a water-soluble carrier layer, a water-soluble pressure sensitive adhesive layer, or a support layer used on the side opposite the application surface of the adhesive layer. Accordingly, Applicants request that the rejections under 35 U.S.C. § 103(a) should be withdrawn.

Conclusion

In view of the arguments offered herein, Applicants respectfully submit that the Examiner's grounds for objection and rejection are overcome and respectfully solicit reconsideration and withdrawal of the rejections to place the application in condition for allowance.

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Respectfully submitted,

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